

**FD3 (P4) – Amendment of Specifications  
Mark Scheme 2015**

**Assessment task**

You have received the letter and documents listed on the Instructions to Candidate sheet regarding United Kingdom patent application number GB 1234321.0 which has been filed at the UK Intellectual Property Office.

**Your task is to prepare:**

- 1. a letter to the UK Intellectual Property Office in response to the Examination Report;**
- 2. a set of amended claims, if considered necessary;**
- 3. notes on which you would base advice to your client in which you**
  - i. explain the actions you have taken and why;**
  - ii. provide full reasoning for your actions;**
  - iii. outline future actions, if any, that your client could take to secure full protection of its commercial interests.**

Your advice should take into account that further information may be required.

Your notes should only relate to the invention(s) outlined in the client's correspondence to you.

Your notes should be directed to patent matters only.

Note the following:

- a) You are NOT required to make any amendments to the description of the client's patent application.
- b) You should accept the facts given to you and base your answer on those facts.
- c) You should not make use of any other special knowledge that you may have of the subject matter concerned.
- d) You should assume that the prior art referred to is complete.
- e) Identify clearly any amended claim set and/or divisional claim(s).

**Allocation of Marks**

**Letter: 35 marks**

**Claims: 35 marks**

**Notes: 30 marks**

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**TRACK 1**

**Claims**

Independent claim to a tube (bin conversion kit) on its own, with fastening means for attaching to bin by a user

**max 15 marks**

- But backup claim to whole bin + tube

**10 marks**

**OR**

Claim 1 to a bin with a vent tube attached/retrofitted using a set of fasteners (5/26); or to a kit including a bin

**25 marks**

Less-than-ideal versions of claim 1:

- Fasteners too specific (e.g. burr fasteners)
- Specific tube (sections etc.)

**max 12 marks**

Other dependent claims:

amend claim 2 for clarity and to say tube passes into housing;

**2 marks**

add some detail of the passage of air from tube through housing;

**1 mark**

tube is in separate parts or is telescopic;

**1 mark**

attachment is adhesive + hook-and-eye, or adhesives + clip;

**2 marks**

tube + housing;

**1 mark**

tube is perforated;

**1 mark**

correct claim 9;

**1 mark**

correct Omnibus claim to refer to two embodiments

**1 mark**

**Total: 35 marks**

**Response letter**

Explain what amendments made

**5 marks**

support for these amendments (page 5 for tube/retrofit)

**8 marks**

Novelty:

bin + attachable tube, not present in D1 (nor D2, of course): in D1 the tube only comes into being when the panel is attached to the bin.

**4 marks**

**Cont...**

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D1 does not contemplate a user (as opposed to a manufacturer) attaching a ready-formed tube to a bin	<b>3 marks</b>
Inventive step: structured approach. retrofit feature greatly extends usefulness;	<b>3 marks</b>
Even if bin sold with tube, no alteration of bin manufacture needed;	<b>2 marks</b>
tube + attachment means in isolation not obvious (what would it be for?);	<b>2 marks</b>
D1 system difficult to apply to round bin;	<b>3 marks</b>
optional housing feature does not waste deodorant.	<b>2 marks</b>
Clarity and procedural: claim 2 now clear; intention to file divisional	<b>3 marks</b>
	<b>Total: 35 marks</b>

**Notes to client**

Explain action taken in view of letter – attempted to cover kit on its own but this is not easy (5), ditto generalisation of “fasteners” (3). Prospects for the application; claim to tube on its own might not survive – probably have to restrict to tube + bin (3); may get a second official letter (1); say new search might be needed in this application for tube on its own (1)	<b>13 marks</b>
Proposed divisional for tube/deodorant housing combination, preferably giving claim wording (6); reason for divisional (1); timing (1)	<b>8 marks</b>
Discuss indirect infringement of a claim to tube + bin by sale of tube kit – likelihood of competing sales of kit alone so preferable to claim kit, but more difficult from the point of view of patentability.	<b>4 marks</b>
There is enough time to consider the best way forward – production not due for another year, no sign of infringers	<b>3 marks</b>
We still cover both embodiments	<b>1 mark</b>
EP 303030 (D2) must have expired (dates)	<b>1 mark</b>
	<b>Total: 30 marks</b>

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**TRACK 2**

**Claims**

*Maximum of only 30 marks available for claims if candidates opt for Track 2*

Claim 1 to an attachable tube kit on its own, including a housing for deodorant into which the tube fits; amend former claim 2 wording for clarity

**max 18 marks**

Dependent claims:

- add some detail of the passage of air from tube through housing; **1 mark**
- tube is in separate parts or is telescopic; **1 mark**
- adhesive fastening; **1 mark**
- attachment is adhesive + hook-and-eye, or adhesives + clip; **2 mark**
- tube is perforated; **1 mark**
- correct claim 9; **1 mark**
- correct Omnibus claim to refer to two embodiments **2 mark**
- claim(s) to bin + kit **3 marks**

**Total: 30 marks**

**Response letter**

Explain what amendments made **5 marks**

support for these amendments, including for free-standing kit **8 marks**

Novelty: combination of tube + fitting housing not present in either D1 or D2; separate tube not shown anywhere **7 marks**

**Cont...**

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Inventive step: structured approach.

Combination of D1 and D2 does not result in (a suitably drafted) claim 1.

**5 marks**

Flow through housing only when opening bin does not waste deodorant.

**5 marks**

Difficult to see how deodorant housing could be applied to vent of D1.

**2 marks**

Clarity and procedural: claim 2 (1) now clear; intention to file divisional

**3 marks**

**Total: 35 marks**

**Notes to client**

Explain action taken in view of letter – covers conversion kit on its own, albeit in the housing version only (4). Desirable to cover simpler version of conversion kit on its own but this is not easy, hence preferable to hive off into divisional (5). Prospects for this application: good arguments for novelty/IS (3); new search might be needed in this application for tube on its own (1)

**13 marks**

Proposed divisional for [bin+]tube/fasteners combination, preferably giving claim wording; reason for divisional; timing

**8 marks**

Discuss advantage for infringement purposes of claiming conversion kit without a bin.

**4 marks**

There is enough time to consider the best way forward – production not due for another year, no sign of infringers

**3 marks**

We still cover both embodiments

**1 mark**

EP 303030 (D2) must have expired

**1 mark**

**Total: 30 marks**